INDEX

CITATIONS

Cases:

Statutes:

465361—42

In the Supreme Court of the United States

OCTOBER TERM, 1942

No. 369

MARCONI WIRELESS TELEGRAPH COMPANY OF AMERICA, PETITIONER

v.

THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

OPINIONS BELOW

The opinion of the Court of Claims on the issues of validity and infringement of the patents in suit (R. 7–116) is reported in 81 C. Cls. 671. The opinion of the Court of Claims on the accounting proceedings (R. 117–182) is not yet officially reported.

JURISDICTION

The interlocutory judgment of the Court of Claims concerning validity and infringement, in

pursuance of which an accounting was held, was rendered November 4, 1935 (R. 75); the final judgment after accounting proceedings was rendered April 6, 1942 (R. 182). The petition for a writ of certiorari was filed September 2, 1942 (R. 2524), pursuant to an extension of time granted by the Chief Justice (R. 2523). The jurisdiction of this Court is invoked under Section 3(b) of the Act of February 13, 1925, as amended.

QUESTIONS PRESENTED

(1) Whether the Court of Claims erred in holding the Marconi patent, No. 763,772, invalid as to all the claims in suit other than Claim 16 (*viz.* as to Claims 1, 2, 3, 6, 8, 10–14 and 17–20).

(2) Whether the Court of Claims erred in holding that Claims 1 and 37 of the Fleming patent, No. 803,684, had not been infringed by the United States.

STATUTE INVOLVED

The Act of June 25, 1910, c. 423, 36 Stat. 851, as amended by the Act of July 1, 1918, c. 114, 40 Stat. 704, 705 (35 U. S. C. § 68), to the extent pertinent reads as follows:

> That whenever an invention described in and covered by a patent of the United States shall hereafter be used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, such owner's remedy shall be by suit against the United States in the Court of Claims for the recovery of

his reasonable and entire compensation for such use and manufacture: * * * *Provided further*, That in any such suit the United States may avail itself of any and all defenses, general or special, that might be pleaded by a defendant in an action for infringement, as set forth in Title Sixty of the Revised Statutes, or otherwise. * * *

STATEMENT

On July 29, 1916, petitioner brought this suit in the Court of Claims under the Act of June 25, 1910, to recover compensation for the alleged unauthorized use by the United States of inventions alleged to have been covered by four patents, two issued to Guglielmo Marconi, one to Sir Oliver Lodge, and one to Sir John Ambrose Fleming. One Marconi patent (reissue No. 11,913) was held not to have been infringed, and as to this no review is sought by petitioner. The Lodge patent (No. 609,154) was held to be valid and infringed, and is not here involved. The remaining two patents are Patent No. 763,772 to Guglielmo Marconi, granted June 28, 1904 (Claims 1, 2, 3, 6, 8, 10, 11, 12, 13, 14, 16, 17, 18, 19, and 20 involved in suit), and Patent No. 803,684 to John Ambrose Fleming, granted November 7, 1905 (Claims 1 and 37 involved in suit).

The court below, in its interlocutory judgment of November 4, 1935, held that all the claims in suit of Marconi Patent No. 763,772, except Claim

16[1] were invalid, and that Fleming Patent No. 803,684 had not been infringed by the defendant (81 C. Cls. 671; R. 75). These holdings were embodied by the court in the ultimate findings of fact (R. 117) made in connection with its final decision of April 6, 1942. The final judgment (R. 182) entered on that date awarded compensation to plaintiff in the amount of $42,984.93, plus interest, for infringement of Claim 16 of the Marconi patent, and in the additional amount of $34,827.79, plus interest, for infringement of the Lodge patent (not here involved).

The evidentiary findings of fact of the court below, supporting the ultimate findings of fact referred to above, may be briefly summarized as follows:

(a) *Marconi Patent No. 763,772 (all claims involved in suit other than Claim 16)* is directed to the tuning of wireless telegraph transmitters and receivers.

The pre-existing transmitter alleged to have been improved consisted of an antenna-circuit (also known as the radiating-circuit) and a charging-circuit. The antenna-circuit had an antenna at one end and a connection to earth at the other; the charging-circuit was coupled to the antenna-circuit through a transformer. The charging-

---

[1] The defendant has filed a petition (No. 373) praying that in the event this Court grants the petition here involved (No. 369), but only in that event, a cross-writ of certiorari be issued to review that portion of the final judgment which awards damages against the United States for infringement of Claim 16 of the Marconi patent.

circuit contained a spark-coil, a charging condenser, and a spark gap—all three being known means for producing high frequency electrical oscillations (Finding XLIII, R. 38).

The pre-existing receiver alleged to have been improved likewise consisted of two circuits: the antenna-circuit which received the oscillations had an antenna at one end and a connection to earth at the other; and the detector-circuit which was coupled to the antenna-circuit through a transformer. Detecting and translating means, as a coherer and telegraph sounder, were connected in the detector-circuit (Fig. 13, Lodge patent, Ex. 20 R. 26), Finding XXVII, R. 24).

The alleged improvement of the Marconi patent (as embodied in all claims involved in suit except Claim 16) consisted in adjusting the inductance and capacity of either the two circuits at the transmitter or the two circuits [1] the receiver, or all four of these circuits to bring them into resonance to the same frequency or wave-length (Findings XXXVIII–XLIII, R. 31–38).

The court below found as facts that the alleged improvement of these claims was anticipated by the prior art (Findings LVII, LVIII, LIX, LXI, LXII, R. 56–60) as follows:

CLAIMS OF MARCONI PATENT INVOLVED IN SUIT	ANTICIPATING PRIOR ART
All claims for four-circuit tuning (except Claim 16)[1]	Stone Patent No. 614,756; and Tesla Patent No. 645,576 in conjunction with Lodge Patent No. 609,154

[1] Claim 16 was sustained for another feature. See cross petition for certiorari in No. 373 this Term, 1942.

[In addition, as anticipating prior art with respect to certain of these claims the Court found]

Claims 2, 12, 18, 39	Marconi Patent No. 627,650
Claims 1, 3	Lodge Patent No. 609,154, Fig. 4
Claim 2	Lodge Patent No. 609,154, Figs. 12, 13
Effecting four-circuit tuning by means of a variable inductance	Lodge Patent No. 609,154

(b) *Fleming Patent No. 803,684 (Claims 1 and 37)* disclosed a radio receiving circuit using as a rectifying detector the two-electrode tube of Edison patent No. 307,031 (Findings LXIV, LXX, LXXI, R. 60, R. 64–67). Fifteen years before the filing of this patent application in 1905 Fleming described in publications the unilateral conductivity of the Edison tube and its ability to rectify alternating currents when connected in a circuit as defined in Claim 1 of the Fleming patent. In 1915, ten years after his patent issued—long after the three-electrode tube had been invented and employed in radio apparatus as detector, amplifier and oscillator, and after the United States had used substantial quantities of three-electrode tubes as detectors and amplifiers—Fleming's assignee filed a disclaimer limiting "the combinations of elements" in certain claims, including Claim 1, and making other modifications in the specification (Findings LXV, LXXI, R. 62, 74).

The opinion of the court below indicated that the Fleming patent may be invalid because the new use it made of the "Edison effect" lacked invention (R. 104–105), and because of insufficiency and unreasonable delay in filing the disclaimer (R. 105–107). However, these matters are not included in

As modified by the disclaimer, the Fleming patent does not include all uses for the electron emissions from the heated electrode of the tube of the Edison patent, nor all uses for such emissions in connection with radio frequencies, but relates only to a *rectifying* use of such emissions of the Edison tube in connection with *alternating* currents of radio frequencies (Finding LXXII, R. 67).

All the alleged infringements comprise use of the three-electrode vacuum tubes of De Forest and purchase of such tubes and apparatus for use (Finding LXXV, R. 69). The defendant's structures used the De Forest three-element vacuum tubes as detectors and amplifiers. In these arrangements (both detector and amplifier), the hot filament and plate of the Edison tube were connected with a *direct current* battery circuit polarized so that current would flow, and the translating device, i. e., headphone, was placed in this battery circuit. In the detector arrangement, the incoming alternating current signal was connected through a grid condenser to a grid placed in the space between the hot filament and the plate so that the audio-components of the received oscillations would alternatingly stop and permit flow of a larger local battery current (Finding LXXV, R.

---

the findings of fact on which the judgment is based (R. 60–74), since those findings are restricted to the pivotal issue of infringement (R. 75).

69); in the amplifier arrangement, the alternating current of audio frequency was also applied to the grid to control increase or decrease of a larger current in the local battery circuit (Finding LXXVI, R. 72).

The court below found that insofar as defendant's structures and the invention disclosed in the Fleming patent had anything in common, the common matter had been disclosed in the earlier Edison patent (Finding LXXII, R. 67); that the Fleming patent was limited to his manner of applying the so-called "Edison effect" (Finding LXXII, R. 67); that the defendant's manner of using the "Edison effect" differed in means, mode of operation and result from that of Fleming (Findings LXV–LXXX, R. 62–74); and that, therefore, defendant's structures did not infringe the Fleming patent (R. 116; Finding I, R. 117).

ARGUMENT

In making the evidentiary findings in support of its ultimate findings as to invalidity of the Marconi patent (except Claim 16) and noninfringement of the Fleming patent, the court below analyzed in detail the prior art relied upon by defendant and pointed out wherein it anticipated or limited the subject matter and claims of these patents. Petitioner has not challenged these analyses, nor has it charged, or made any showing, that there is a lack of substantial evidence to sustain the findings, or that any ultimate finding is not sustained by the

evidentiary findings. Likewise no contention has been made, nor could it have been made, that the court below failed to make any finding of fact on a material issue. There is thus no basis for review under the 1939 amendments to the Act of February 13, 1925, providing for review by certiorari of decisions of the Court of Claims.[4]

As the sole reasons for allowing the writ petitioner urges (1) an alleged conflict between the conclusions reached below and several decisions of the lower federal courts, and (2) recommendations of an administrative board in 1921 that Congress enact legislation awarding petitioner a greater sum

---

[4] Section 3 (b) of the Act of February 13, 1925, c. 229, 43 Stat. 936, as amended by the Act of May 22, 1939, c. 140, 53 Stat., part 2, 752, provides that in cases of certiorari to the Court of Claims, "the Supreme Court shall have authority to review, in addition to other questions of law, errors assigned to the effect that there is a lack of substantial evidence to sustain a finding of fact; that an ultimate finding or findings are not sustained by the findings of evidentiary or primary facts; or that there is a failure to make any finding of fact on a material issue."

Indeed, the only questions involved—the issue of invalidity with respect to the Marconi patent, and the issues of scope of claims and of infringement with respect to the Fleming patent, are purely factual. *United States* v. *Esnault-Pelterie*, 299 U. S. 201; 303 U. S. 26, 29. And even before the Act of May 22, 1939, decisions of the Court of Claims upon such matters were not subject to review by this Court except where the ultimate findings were not sustained by the evidentiary findings. *United States* v. *Esnault-Pelterie*, 303 U. S. 26. The decision of such issues in the federal courts will not ordinarily be reviewed except to resolve a conflict of decision between circuit courts of appeals. *Keller*

than it has recovered below. Neither of these grounds justifies the issuance of the writ.

1. *The decision below does not conflict with decisions of other federal courts on either of the two questions in this case.*

The Marconi patent here involved was considered by the federal courts in three reported cases, but, as the Court of Claims pointed out in its decision of this case (R. 95–102), none of these adjudications is inconsistent with the result reached below. In *Marconi Wireless Telegraph Co. of America* v. *National Electric Signaling Co.*, 213 Fed. 815 (E. D. N. Y.), the District Judge held the Marconi patent valid and infringed, but the defense of the prior art Stone patent (which the Court of Claims relied upon in this case to hold the patent invalid) was neither presented nor referred to. *Marconi Wireless Telegraph Co. of America* v. *De Forest Radio Telephone & Telegraph Co.*, 225 Fed. 65 (S. D. N. Y.), affirmed 225 Fed. 373 (C. C. A. 2), involved a motion for preliminary injunction under the Marconi patent. The court, merely issuing preliminary relief against infringement, did not pass upon the question of validity. In *Marconi Wireless Telegraph Co.* v. *Kilbourne & Clark Mfg. Co.*, 239 Fed. 328 (W. D. Wash.), affirmed 265

---

v. *Adams-Campbell Company*, 264 U. S. 314, 319; *Layne & Bowler Corporation* v. *Western Well Works, Inc.*, 261 U. S. 387; *cf. General Talking Pictures Corp.* v. *Western Electric Company*, 304 U. S. 175. There is no such conflict here.

Fed. 644 (C. C. A. 9), the district court, again not passing upon validity, merely held the Marconi patent not to have been infringed. While the "Stone" defense was before the court, it was presented solely to sustain the defense of "noninfringement of the invention as limited by the prior art," and the circuit court of appeals in affirming the decision as to noninfringement expressly recognized defendant's position in this respect (265 Fed. 646). The significance of the court's language as to validity is thus considerably diminished. Of greater significance is the fact, as the court below recognized (R. 97–99), that anticipation by Lodge Patent No. 609,154 taken with Tesla Patent No. 645,576—the other basis for the Court of Claims' conclusion of invalidity—was not considered in that decision.

The Fleming patent was considered by the federal courts in two cases, neither of which involved the question of infringement here presented. In *Marconi Wireless Telegraph Co.* v. *De Forest Radio Telephone & Telegraph Co.*, 236 Fed. 942 (S. D. N. Y.), the plaintiff sued for infringement of the Fleming patent by the use of the three-electrode tube, alleging that it was the same in principle as the Fleming two-electrode tube. The defendant agreed they were the same in principle, but urged that the hot-gas tube patents of defendant, which were earlier than the Fleming patents, were also the same in principle. The court held the hot-gas

tube patents to be different in principle, and the Fleming patent to be valid and infringed. The Circuit Court of Appeals for the Second Circuit affirmed (243 Fed. 560), noting that both parties agreed the two-element and three-element tubes were the same in principle. In 261 Fed. 393, the district court extended the decree to oscillators, on the theory that the Fleming valve was inherently capable of oscillating. Since there was no conflict between the parties in that litigation as to the point most important to the issue of infringement here involved—*viz.*, whether the two-electrode and three-electrode tubes are different in principle—the decision cannot be deemed a holding in conflict with the result reached below.[1] Nor did *Radio Corporation of America* v. *Radio Audion Co.*, 278 Fed. 628 (Del.), pass on the point here involved.[2]

The decisions of the British and French courts to which petitioner refers plainly have no application, being rendered under different patents and different statutory standards.

2. Petitioner makes reference to the recom-

---

[1] In this connection it should be noted that the findings and opinion of the Court of Claims in the present case as to the operation of the three-electrode tube are in accord with the analysis thereof made by this Court in *De Forest Radio Co.* v *General Electric Co.*, 283 U. S. 664.

[2] In that case, the district court, without explanation, but apparently following the *De Forest* case (Pet. 22, note 26) granted a preliminary injunction under the Fleming patent as to detectors, but refused to grant restraint as to amplifiers and oscillators.

mendation of an Interdepartmental Board in 1921 that legislation be enacted granting petitioner $1,250,000 for respondent's use of the Marconi, Fleming, and Lodge patents (Pet. Br. p. 20). Not only is this factor irrelevant, but whatever significance is sought to be attached to it is virtually nullified by petitioner's admission that the recommendation, which was based upon an *ex parte* presentation by petitioner, was without prejudice and not binding upon the Government, and was rejected by Congress (Pet. Br. pp. 20, 26).

Since the patents in suit have long since expired (Pet. Br. 12), no question of importance with respect to the patents is here involved. And no novel question of law is presented by this case.

CONCLUSION

The decision of the court below is correct. There is no conflict and no question of importance is involved. It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

CHARLES FAHY,
Solicitor General.
FRANCIS M. SHEA,
Assistant Attorney General.
C. V. EDWARDS,
Special Assistant to the Attorney General.
D. L. KREEGER,
J. Y. HOUGHTON,
Attorneys.

NOVEMBER 1942.